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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/751,196

12/29/2000

Tony B. Marshall

9203/055

8536

24283

7590

09/07/2004

PATTON BOGGS

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EXAMINER

BRIER, JEFFERY A

ART UNIT

PAPER NUMBER

2672

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/751,196	<b>Applicant(s)</b> MARSHALL ET AL.	
	<b>Examiner</b> Jeffery A Brier	<b>Art Unit</b> 2672	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/13/2001</u> . | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____.<br>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)<br>6) <input type="checkbox"/> Other: _____. |
|--|--|

**DETAILED ACTION**

***Oath/Declaration***

1. The declaration filed on 3/12/2001 has been entered.

***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

reference numbers 413 and 414 of figure 4 do not have a detailed description other than a brief introduction at page 23 line 27;

reference number 704 of figure 7; and

Database G and P1 of figure 1A

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9, 10, 32, 33, 55, 56, 61, and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9, 10, 32, 33, 55, and 56:

Claim 9 at lines 2-4 claim "at least one of the display object manipulation functions of: crop, rotate, size, reposition, enlarge, and the like." The phrase "and the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). Claims 32 and 55 claim the same limitation. Claims 10, 33 and 56 claim the same limitation due to their dependency and they do not correct this issue.

Claims 61 and 62:

Claim 61 depends upon claim 47 but should depend upon claim 57. This claim is indefinite because "said at least one virtual memories product" lacks antecedent basis in the claim.

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***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaffer et al., US Patent Application Publication No. 2001/0046330.

Shaffer teaches a system that allows a user to upload digital photos, themes and other media to a processing facility in order to generate a photo album or photo collage.

Method claims 24-46 and means plus function claims 47-69 claim the same functions as corresponding means plus function claims 1-23. These claims are rejected for the same reasons given below for claims 1-23.

A detailed analysis of the claims follows.

Claims 1, 24 and 47:

Shaffer teaches a memories product generation system for automatically generating a memories product (*see the abstract and paragraph 0010.*), said memories product being customized for at least one of a customer and a recipient (*Shaffer customizes the photo album or photo collage for a*

*customer who may be the recipient or who may give the photo album or photo collage as a gift to a recipient. ), said memories product generation system comprising:*

*means for inputting a plurality of memories materials, each of which comprises data that represents a display object (See figures 1, 2, 4 & 6 and paragraphs 0025, 0036 & 0039. The term display object is met by each separate photo, video, or audio the user uploads.);*

*means for providing a customer with an interface to define at least one topic for said memories product (See paragraph 0027 which discusses having the customer select a theme such as birthday photo collage. The means which allows the user to input the theme is a an interface.);*

*means for storing data that identifies at least one of a customer and a recipient who is to receive said memories product (Shaffer customizes the photo album or photo collage for a customer who may be the recipient or who may give the photo album or photo collage as a gift to a recipient. Information stored in the customer profile, see paragraph 0025 last sentence, would indicate at least the customer. The customer may be the recipient, thus, the customer of Shaffer is both the customer and the recipient. Additionally it should be noted that many system allow the customer to have the product shipped to a location other than the billing address*

*of the customer in order to allow the customer to send the product to a recipient different than the customer.); and*

*means for automatically generating at least one memories product (photo album or photocollage), that comprises a plurality of display objects (The term display object is met by each separate photo, video, or audio the user uploads.) formed from said memories materials (The term memories materials is met by each separate photo, video, or audio the user uploads.), said at least one memories product being in a form and content that is customized for said at least one of a customer and a recipient (The photo album or photocollage is customized to the customer and the selected theme.).*

Claim 24 is a method claim version of means plus function claim 1. Claim 24 claims the same functions claimed in claim 1 and is rejected for the same reasons given for claim 1.

Claim 47 is a means plus function claim that claims the same functions that means plus function claim 1 claims and is rejected for the same reasons given for claim 1.



Claims 2, 25 and 48:

Shaffer teaches the memories product generation system of claim 1 wherein said means for inputting a plurality of memories materials comprises:

means for digitizing at least one image (*The digital still camera, digitization services 22, and digitization scanning 18 described in paragraph 0025 are the same applicants means for digitizing.*);  
and

means for uploading said at least one digitized image to a memory (*The processing facility 14 uploads the digitized images into memory 20, see figure 2 and paragraph 0025. Also see figure 4 where communication interface 92 is a means for uploading digitized images into storage 102.*).

Claims 3, 26 and 49:

Shaffer teaches the memories product generation system of claim 2 wherein said memory is located remotely from said means for automatically generating (*See figure 2. Data store 20 is remote from the processor 37. Data storage 102 is separate from computer 94.*), said means for inputting a plurality of memories materials further comprises:

means for transmitting said at least one digitized image to a memory collocated (*Processing goal generation 37 inherently has a memory. Computer 94 inherently has system memory that is remote from storage 102.*)

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with said means for automatically generating via a communication medium that interconnects said remotely located memory with said means for automatically generating (*Data store 20 and storage 102 are connected by a communication medium to processor 37 or computer 94 that is equivalent to applicant communication medium.*).

Claims 4, 27 and 50:

Shaffer teaches the memories product generation system of claim 1 wherein said means for inputting a plurality of memories materials comprises: means for accessing a memory that stores a plurality of memories materials (*The digitization services 80, kiosk 88 and PC 90 have memory for storing the digitized images and have a means for accessing those digitized images for uploading to photo album or photocollage processor. Film 10 and prints 6 supplied to the processing facility are also memory and the means for accessing these memory are the physical transportation system that moves these items from the customer to the processing facility 14.*); and

means for uploading at least one of said plurality of memories materials via a communication medium (*Both the electronic and physical communication means uploads the customers images, videos and audio to the processing facility.*).

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Claims 5, 28 and 51:

Shaffer teaches the memories product generation system of claim 1 wherein said means for providing a customer with an interface comprises:

means for retrieving at least one of recipient and customer characteristic data from said customer via a series of queries presented to said customer via at least one display screen (*See figure 4 and paragraph 0036 which describes having the customer fill out the order which inherently has questions regarding the customer including the desired theme.*).

Claims 6, 29, and 52:

Shaffer teaches the memories product generation system of claim 5 wherein said means for providing a customer with an interface further comprises:

means for storing said characteristic data in a memory (*Customer profile 30 is a database in memory 20 and 102.*).

Claims 7, 30, and 53:

Shaffer teaches the memories product generation system of claim 5 wherein said means for providing a customer with an interface further comprises:

means for retrieving said characteristic data (*Customer profile data 30.*) from a memory located remote from said means for automatically generating in response to said customer identifying said memory (*See the discussion above concerning remote memory presented in the discussion of claim 3.*

*The customer identifies the memory when the customer at least contacts the data store 20 to order the photo album, see the last three sentences of paragraph 0025. When the customer places the order the system will located the memory storing the photos, video and audio based upon the customer's order information and the theme selected by the user.).*

Claims 8, 31, and 54:

Shaffer teaches the memories product generation system of claim 1 wherein said memories product contains at least one page, said means for automatically generating comprises:

means for producing a layout for said page of said memories product  
*(Automatic generation of photo album based upon the custormer's selected theme generates the layout of the photo album.), said page layout comprising a plurality of display objects (Each photo, video, audio of the photo album is a display object.), each display object having a plurality of characteristics (Metadata 34 and order information 36. See paragraph 0025.) which define a content (The metadata and the theme data define the content of each photo, video, audio of the photo album.) of an image created from said display object and a locus of said image created from said display object on said page (The metadata and theme data define a locus for the image generated which forms the photo*

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*album page(s) or photocollage page(s).*

Claims 9, 32, and 55:

Shaffer teaches the memories product generation system of claim 8 further comprising:

means for enabling said customer to manipulate said display objects, including at least one of the display object manipulation functions (Paragraph 0033 which describes the enhancement module applying image processing based upon the intended story which is selected by the user.) of:

crop (See paragraph 0033 line 7, paragraph 0044 line 14-16. ),

rotate (See paragraph 0033 lines 20-23, Adobe Photoshop, Kodak Imaging Workstation and Picture-It allow the user to rotate the image. Paragraph 0037 describes the user selecting portrait or landscape which would require the system to rotate the image.),

size (See paragraph 0033 line 7, paragraph 0044 line 14-16.),

reposition (The order description includes theme of the intended story which controls placement of photos, video, audio, etc.),

enlarge (See paragraph 0033 line 7, paragraph 0044 line 14-16.),

and the like (See paragraph 0033 lines 5-7 and 14-16. ).

Claims 10, 33, and 56:

Shaffer teaches the memories product generation system of claim 9 further comprising:

means for automatically selecting at least one display attribute for said page excluding said display images, from the class of display attributes including: titles (Annotations see paragraph 0032.), borders (Paragraph 0044 describes selecting a background via customer preferences. A background will border each photo, thus, at this disclosure of Shaffer meets this claim limitation.), backgrounds (Paragraph 0044 describes selecting a background via customer preferences.), graphics (See paragraph 0033 lines 13-16.), stories (See paragraph 0034.) and placement (Grouping of the image based upon the theme is placement of the images according to the display attribute of the theme excluding the display image's attributes.) of memories materials (At least the customer's photos meet this claim limitation.).

Claims 11, 34 and 57:

Shaffer teaches the memories product generation system of claim 1 wherein said means for automatically generating comprises:

means for automatically generating at least one virtual memories product, that comprises a plurality of display objects formed from said memories materials and viewable in electronic form by said customer (*Paragraph 0039 describes an electronic embodiment which allows the customer to view the pages of the photo album after automatic generation to allow the user to make changes to the generated photo album via drag and drop or choosing form a list.*).

Claims 12, 35, and 58:

Shaffer teaches the memories product generation system of claim 11 wherein said means for automatically generating further comprises:

means for enabling said customer to edit said at least one virtual memories product (*Paragraph 0039 describes an electronic embodiment which allows the customer to view the pages of the photo album after automatic generation to allow the user to edit the generated photo album via drag and drop or choosing form a list.*).

Claims 13, 36, and 59:

Shaffer teaches the memories product generation system of claim 12 wherein said means for automatically generating further comprises:

means for enabling said customer to store said at least one virtual memories product in memory (*Paragraph 0039 describes an electronic embodiment which allows the customer to view the pages of the photo album after automatic generation to allow the user to make changes to the generated photo album via drag and drop or choosing from a list. After the changes are made the changes are sent to the retail site. This would cause the edited photo album to be stored in memory. Additionally when the photo processor downloads the photo album to allow the customer to view the automatically generated photo album the customer's computer has stored this photo album in response to the user's request to view the photo album.*).



Claims 14, 37, and 60:

Shaffer teaches the memories product generation system of claim 13 wherein said means for automatically generating further comprises:

means for retrieving said stored virtual memories product from said memory (*The customer's computer will read the stored downloaded photo album to allow the customer to view and edit the photo album.*); and

means for enabling said customer to edit said retrieved virtual memories product to create another virtual memories product (*Paragraph 0039 describes an electronic embodiment which allows the customer to view the pages of the photo album after automatic generation to allow the user to make changes to the generated photo album via drag and drop or choosing from a list. The edited photo album is a another memory product since it is different.*).

Claims 15, 38, and 61:

Shaffer teaches the memories product generation system of claim 11 further comprising:

means for routing said at least one virtual memories product, viewable in electronic form, to at least one individual other than said customer (*Paragraph 0039 describes an electronic embodiment which allows the customer to view the pages of the photo album after automatic generation to*

*allow the user to make changes to the generated photo album via drag and drop or choosing from a list. This information is sent to the retail site which initiates printing of the final photocollage. The retail site has people who are individuals other than the customer.).*

Claims 16, 39, and 62:

Shaffer teaches the memories product generation system of claim 15 wherein said means for automatically generating further comprises:

*means for enabling said at least one individual to edit said at least one virtual memories product (Figure 4 and paragraph 0036 describes the retail site 93 receiving photo albums from the customer's personal computer 90. The retail site personal at computer 93 uses operator interface 96 to make needed changes to the photo album submitted by the customer. The edited photo album may be the customer's first submission or may be in view of paragraph 0039 a subsequent submission of a customer edited photo album.).*

Claims 17, 40, and 63:

Shaffer teaches the memories product generation system of claim 11 wherein said means for automatically generating further comprises:

*means for enabling said customer to initiate production of said at least one memories product from said at least one virtual memories product (Paragraph 0039 describes an electronic embodiment which allows the customer to view the pages of the photo album after automatic generation to*

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*allow the user to make changes to the generated photo album via drag and drop or choosing from a list. This information is sent to the retail site which initiates printing of the final photocollage.).*

Claims 18, 41, and 64:

Shaffer teaches the memories product generation system of claim 1 wherein said means for automatically generating comprises:

*means for correlating a topic selected by said customer with said memories materials and said data that identifies at least one of a customer and a recipient (The theme selected by the customer who is the claimed customer and recipient causes the system to search through photos, etc. to retrieves photos, etc. that correlate to the selected theme. See paragraph 0031 which describes the grouping of photos, etc according to the selected theme.) who is to receive said memories product to automatically select a plurality of memories materials for inclusion in said at least one memories product.*

Claims 19, 42, and 65:

Shaffer teaches the memories product generation system of claim 18 wherein said means for automatically generating further comprises:

means for automatically formatting said selected plurality of memories materials into at least one virtual memories product (*Paragraph 0033 describes formatting such as red-eye removal, brightness and contrast adjustment, color adjustment, and crop and zoom.* ), that comprises a plurality of display objects formed from said memories materials and viewable in electronic form by said customer (*Paragraph 0039 describes an electronic embodiment which allows the customer to view the pages of the photo album after automatic generation to allow the user to make changes to the generated photo album via drag and drop or choosing from a list.*).

Claims 20, 43, and 66:

Shaffer teaches the memories product generation system of claim 19 wherein said means for automatically generating further comprises:

means for enabling said customer to edit said at least one virtual memories product (*Paragraph 0039 describes an electronic embodiment which allows the customer to view the pages of the photo album after automatic generation to allow the user to edit the generated*

*photo album via drag and drop or choosing from a list.).*

Claims 21, 44, and 67:

Shaffer teaches the memories product generation system of claim 20 wherein said means for automatically generating further comprises:

means for enabling said customer to store said at least one virtual memories product in memory (Paragraph 0039 describes an electronic embodiment which allows the customer to view the pages of the photo album after automatic generation to allow the user to make changes to the generated photo album via drag and drop or choosing from a list. After the changes are made the changes are sent to the retail site. This would cause the edited photo album to be stored in memory. Additionally when the photo processor downloads the photo album to allow the customer to view the automatically generated photo album the customer's computer has stored this photo album in response to the user's request to view the photo album.).

Claims 22, 45, and 68:

Shaffer teaches the memories product generation system of claim 21 wherein said means for automatically generating further comprises:

means for retrieving said stored virtual memories product from said memory (*The customer's computer will read the stored downloaded photo album to allow the customer to view and edit the photo album.*); and

means for enabling said customer to edit said retrieved virtual memories product to create another virtual memories product (*Paragraph 0039 describes an electronic embodiment which allows the customer to view the pages of the photo album after automatic generation to allow the user to make changes to the generated photo album via drag and drop or choosing from a list. The edited photo album is a another memory product since it is different.*).

Claims 23, 46, and 69:

Shaffer teaches the memories product generation system of claim 21 wherein said means for automatically generating further comprises:

means for enabling said customer to initiate production of said at least one memories product from said at least one virtual memories product (*Paragraph 0039 describes an electronic embodiment which allows the customer to view the pages of the photo album after automatic generation to*

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*allow the user to make changes to the generated photo album via drag and drop or choosing from a list. This information is sent to the retail site which initiates printing of the final photocollage.).*

### **Prior Art**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shaffer et al., US Patent Application Publication No. 2001/0041020 , teaches a system similar to Shaffer et al., US Patent Application Publication No. 2001/0046330, but of a more limited disclosure in certain aspects.

Squilla et al., US Patent No. 6,362,900, teaches a system for allowing a user to select a theme which the system uses in the generation of a photo album.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is 703-305-4723. The examiner can normally be reached on M-F from 6:30 to 3:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (703) 305-4713). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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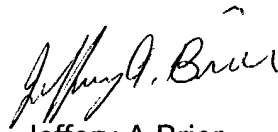
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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jeffery A. Brier". The signature is written in a cursive, flowing style.

Jeffery A Brier  
Primary Examiner  
Art Unit 2672